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Patent Legal Staff  
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In re Application of	:	DECISION ON
Thierry Prigent	:	
PCT No.: PCT/EP2005/001604	:	
Application No.: 10/598,451	:	PETITION UNDER
Int. Filing Date: 17 February 2005	:	
Priority Date: 03 March 2004	:	
Attorney's Docket No.: 86929WRZ	:	37 CFR 1.47(b)
For: METHOD OF IMAGE STORAGE	:	

This decision is in response to applicant's "PETITION BY PARTY HAVING PROPRIETARY INTEREST TO FILE APPLICATION ON BEHALF OF INVENTOR WHO REFUSES TO SIGN (37 CFR 1.47(b))" submitted on 10 August 2007 that seeks the acceptance of the application without the signature of the inventor Thierry Prigent. Applicant has been charged the requisite \$130 petition fee to Deposit Account No. 50-0225 as authorized in the petition.

**BACKGROUND**

On 17 February 2005, applicant filed international application PCT/EP2005/001604, which claimed priority of an earlier application filed 03 March 2004.

On 31 August 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). However, no executed declaration or oath was submitted at such time.

On 11 June 2007, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating, *inter alia*, that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it: is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), applicant filed on 10 August 2007, the, *inter alia*, following:

- 1) a petition under 37 CFR 1.47(b);
- 2) a statement by Etienne Weber; and

3) the required petition fee.

### DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Applicant has satisfied item (1) but not items (2) – (6) thus not completing the requirements under 37 CFR 1.47(b).

Applicant has satisfied item (1) since the petition fee has been provided by applicant.

Regarding requirement (2), although petitioner has concluded that Thierry Prigent has refused to sign the declaration the petition does not include sufficient proof to establish that inventor Mr. Prigent has refused to execute the application. The standards for proof are set forth in MPEP § 409.03(d), which provides:

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted....

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the non - signing inventor, or, if the non - signing inventor is represented by counsel, to the address of the non - signing inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

In the present instance, a complete set of the application papers were not presented to Thierry Prigent for his signature. Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for his signature. From the declaration provided by Etienne Weber, there was no bona fide attempt to send the application papers to Prigent for his signature at his last known address since Etienne Weber only mentions sending the Combined Declaration and Power of Attorney on paragraphs 4 and 8. In addition, the signed confirmation has not been translated to English.

Consequently, the petition does not include sufficient factual proof that Thierry Prigent refuses to sign the required papers.

Regarding item (3), petitioner has not specifically stated the last known address of the non-signing inventor:

Regarding item (4) petitioner has not provided an executed declaration signed behalf of non-signing sole inventor.

Regarding item (5) petitioner has not submitted sufficient proof that applicant has a proprietary interest in the application. A copy of the employment agreement has been submitted but it refers to an invention entitled "Sensipatch application to color film archiving and color fading restoration while de-archiving images" and not the invention of the present application "Method of Image Storage." Moreover, petitioner has not provided proof that these are the same invention.

Regarding item (6) applicant has not presented an adequate showing that the granting of this petition is necessary to preserve the rights of the parties or to prevent irreparable damage if the response to the missing parts of the application is not timely.

Accordingly, since items (2) – (6) under 37 CFR 1.47(b) have not been met it is not appropriate to accord the national stage application status at this time.

### **CONCLUSION**

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read "R. Bacares", is written over the printed name.

Rafael Bacares

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